



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,282	06/22/2001	Leslie Mark Ernest	FIS920010124US1	6450

7590

10/20/2005

Sean F. Sullivan  
Cantor Colburn LLP  
55 Griffin Road South  
Bloomfield, CT 06002

EXAMINER

JABR, FADEY S

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/887,282

Applicant(s)

ERNEST ET AL.

Examiner

Fadey S. Jabr

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/22/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: the drawings filed on July 5, 2001 included two new figures, 6A and 6B, which both lack descriptions within the specification.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims **1, 7, and 13** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim **1, 7, and 13** discloses identifying a customer value proposition, and balancing a normalized centralization/consolidation strategy with a centralization/consolidation strategy. However, the specification fails to disclose a means of enabling the above claims in a manner that would allow one having ordinary skill in the art to make and/or use the invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3639

5. Claims **1-18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claims 1, 2, 5-8, 11-14, 17, and 18** the recitations of the terms “reflecting, strategy, maximizing, primarily elements and benefits” are vague and indefinite for not providing a clear and concise explanation of the terms. Also, lines 14-15 in claims 1, 7, and 13, which discloses, “maximizing the value of said information technology...” is vague and indefinite, because it is unclear as to how the applicant maximizes said value. It is unclear to the Office what the applicant is attempting to set forth. Appropriate correction is required for the above claims and any subsequent recitations of the terms.

As per **4, 10 and 16**, it is unclear to the Office if the applicant is attempting to claim a centralized, consolidated strategy, a centralized, deconsolidated strategy, a decentralized, consolidated strategy, a decentralized, deconsolidated strategy, or if the applicant is attempting to claim a strategy that contains all of the items recited in the claim limitation.

***Claim Rejections - 35 USC § 101***

Claims **1-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per Claims 1-18, these claims recite a series of steps and are considered for the purpose of analysis under 35 U.S.C. 101 as reciting a series of steps. The claims do not recite a pre- or post-computer activity but merely perform a series of steps of identifying, determining, and maximizing data such as perceived values, and is directed to non-statutory subject matter. A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the claims merely manipulate an abstract idea (selecting, storing, generating and transmitting data) or perform a purely mathematical algorithm without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335,200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine

Art Unit: 3639

whether the claimed invention produces a “use, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

Art Unit: 3639

The claims, as currently recited, appear to be directed to nothing more than a series of steps of identifying, determining, and maximizing data such as perceived values without any useful, concrete and tangible result and are therefore deemed to be non-statutory. These values are neither tangible, concrete nor does there appear to be any useful result, since the resulting value is not repeatable seeing as it is based on an end user's perceived value.

Furthermore, it is noted that there is no interrelationship between the independent claim preamble and the body of the claim. For instance, claim 1 preamble recites: "A method for improving an information technology (IT) infrastructure for an organizational entity: but the claim steps of identifying, determining, and maximizing data fail to accomplish the result of actually improving an information technology infrastructure for an organizational entity.

As per **Claim 13**, the preamble recites "a computer data signal comprising code configured to cause a processor to implement a method", however, does not recite that the computer data signal is encoded or recorded on a physical medium readable by a computer. Thus, the claim is directed to functionally descriptive material that is not functionally or structurally interrelated to the medium. Data structures not claimed as embodied in computer readable media (defined as "a collective word for the physical material, such as paper, disk, and tape, used for storing computer-based information", Microsoft Press, Computer Dictionary, Second Edition, © 1994) are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. Such claimed data structures do not define any structural and functional interrelationships between the data structure. See MPEP 2106(IV)(B)(1)(a).

Also, the claim does not recite that the computer program product comprises a computer readable medium having computer readable program instructions or code embodied thereon and configured to control a computer to perform specific functional steps. The lack of recitation of any specific computer or computer implemented device results in a claim that recites functionally descriptive material (defined as “data structures and computer programs with impart functionality when encoded on a computer readable medium” by the Computer-Implemented Invention Guidelines) without any interrelationships between the data structure and other aspects of the invention that would permit the data structure’s functionality to be realized.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims **1-3, 7-9, and 13-15** are rejected under 35 U.S.C. 102(a) as being anticipated by International Business Machines Corporation, (IBM), “Managing information technology in a new age”, hereinafter referred to as IBM.

As per **Claims 1, 7 and 13**, IBM discloses a method for improving an information technology (IT) infrastructure for an organizational entity, the method comprising:

- identifying a customer value proposition for the organizational entity, said customer



Art Unit: 3639

value proposition reflecting an IT end user's perceived value derived from the use of information technology services (Page. 9, lines 4-5, 10-18);

- determining a centralization/consolidation strategy for each of a plurality of infrastructure domains, said centralization/consolidation strategy reflecting the degree of centralization and consolidation to be implemented within said domains (Page 2, lines 5-8, 20-26; Page 10, lines 1-7, 20-26); and

- determining a normalized centralization/consolidation strategy over all of said plurality of infrastructure domains (Page 2, lines 22-26);

- wherein said normalized centralization/consolidation strategy balances said centralization/consolidation strategies for each of said plurality of infrastructure domains, thereby maximizing the value of said information technology services in accordance with said identified customer value proposition (Page 1, lines 7-11).

As per **Claims 2, 8 and 14**, IBM further discloses a method wherein said identifying a customer value proposition for the organizational entity further comprises determining a relationship profile for the organizational entity, said relationship profile further comprising one of a:

- a commodity relationship profile, said commodity relationship profile characterized primarily by cost control and economy of scale objectives (Page 10, lines 20-26);

- a utility relationship profile, said utility relationship profile characterized by cost control and end-user satisfaction objectives;

- a partner relationship profile, said partner relationship profile characterized by end-

Art Unit: 3639

user satisfaction and localized control objectives; and

- an enabler relationship profile, said enabler relationship profile characterized by end-user satisfaction and standardization objectives.

As per **Claims 3, 9 and 15**, IBM further discloses a method wherein said centralization/consolidation strategy further comprises one of:

- a centralized, consolidated strategy  
(Page 2, lines 5-8, 20-26; Page 10, lines 1-7, 20-26);
- a centralized, de-consolidated strategy;
- a decentralized, consolidated strategy; and
- a decentralized, de-consolidated strategy.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims **4, 10, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM.

As per **Claims 4, 10 and 16**, IBM fails to disclose a method wherein:

- a centralized strategy is characteristic of an increased emphasis on control and

standardization of the IT infrastructure;

- a decentralized strategy is characteristic of a decreased emphasis on control and

standardization of the IT infrastructure;

- a consolidated strategy is characteristic of an increased emphasis on economies of scale and physical co-location of IT infrastructure elements; and

- a de-consolidated strategy is characteristic of a decreased emphasis on economies of scale and physical co-location of IT infrastructure elements.

However, the difference between a centralized strategy as disclosed by IBM, and the specific components of the applicant's disclosed method are only found in the non-functional descriptive material and are not functionally involved in the system components recited. The providing of a centralized strategy, decentralized strategy, a consolidated strategy, or a deconsolidated strategy would be performed the same regardless of the descriptive material since none of the strategies explicitly interact therewith. In other words, the specific attributes of the applicant's disclosed strategies would only mean something to a person creating the system after the system is complete. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to include an increased emphasis on certain attributes because such data does not

Art Unit: 3639

functionally relate to the attributes in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

10. Claims **5, 11 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Vellante et al., Pub. No. US2002/0178095 A1.

As per **Claims 5, 11 and 17**, IBM discloses a method comprising:

- identifying individual elements within said domains (Page 10, lines 14-18);
- identifying benefits associated with said individual elements (Page 7, lines 9-13);

Nonetheless, IBM fails to disclose:

- identifying costs associated with said individual elements;
- performing a cost/benefit analysis for said elements within said domains;
- wherein said value of said information technology services is determined by

subtracting the sum total of said costs of each of said elements within each of said domains from the sum total of the benefits of each of said elements within each of said domains.

However, Vellante et al. teaches identifying cost associated with individual elements (Page 9, lines 1-5). Vellante et al. fails to teach performing a cost/benefit analysis and determining said information technology value by subtracting said costs from the sum total of the benefits.

Nevertheless, Vellante et al. teaches performing a cost analysis and determining said information technology value by subtracting the cost from the budget (Page 7, lines 9-13; Page 9, lines 1-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of IBM and include performing a cost/benefit analysis and

Art Unit: 3639

subtracting the costs from the sum total of the benefits as taught by Vellante et al. because it would greatly improve the information technology value by performing a more thorough analysis of the costs and benefits of the information technology.

11. Claims **6, 12 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Vellante et al., Pub. No. US2002/0178095 A1 as applied to claims 1, 7, and 18 above, and further in view of Ruffin et al., U.S. Patent No. 6,675,149 B1.

As per Claims 6, 12 and 18, IBM fails to disclose a method wherein identifying benefits associated with said individual elements further comprises:

- identifying attributes of said individual elements; and
- determining common attributes among said individual elements, thereby linking said

individual elements with a business function provided thereby.

However, Ruffin et al. teaches identifying common attributes in the system (Col. 24, lines 38-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of IBM and include identifying common characteristics of individual elements of the system as taught by Ruffin et al. because an improved information technology value can be determined if the characteristics of the IT services are known.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Vellante et al., Pub. No. US2002/0069102 A1

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

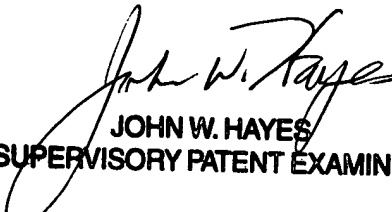
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr  
Examiner  
Art Unit 3639

FSJ



**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**